

REMARKS

In view of the following remarks, the Examiner is requested to allow Claims 1-11, 22-28 and 36-38, the only claims pending and under examination in this application.

Claim 28 was amended to clarify the claim language. Support for the amendment is found throughout the disclosure, particularly in Fig. 6. No new matter has been added.

Claim 38 has been amended to clarify the claim language and to depend from Claim 36, rather than Claim 1. No new matter has been added.

Claim Rejections – 35 U.S.C. § 112

Claim 28 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As indicated above, Claim 28 has been amended to clarify the claim language. As such, the Applicants submit that this rejection has been adequately addressed and may be withdrawn.

Claim Rejections – 35 U.S.C. § 101

Claim 38 was rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Specifically, the Examiner cites to the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, and asserts that “as claimed, the method does not produce a tangible result.” Office Action, pg. 3-4 (citing Guidelines, pg. 19-20).

As shown above, Claim 38 has been rewritten in dependent claim form, such that Claim 38 depends from Claim 36, which ultimately depends from independent Claim 1. Consequently, Claim 38 incorporates all the elements of the claims from which it depends. As such, the Applicants submit that this rejection has been adequately addressed and may be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 3-4 and 11 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cattell et al. (International Genome Sequencing and Analysis

Conference, vol. 12, pg. 106 (2000)) as evidenced by the definition of “pipeline” (obtained online at www.credoreference.com on March 2, 2008).

The claims of this case (e.g., claims 1-11, 22-28 and 36-38), require that feature characteristics are extracted from data obtained from a first array while a second chemical array is being read.

In maintaining this rejection, the Examiner alleges that “The method of Cattell et al. discloses reading and extracting data from multiple arrays in a pipelined fashion in an automated system.” Office Action, pg. 6, lines 1-2. In addition, the Examiner alleges that “It is inherent that the term ‘pipeline’ signifies [] simultaneity in execution of the reading and extracting of data in the microarrays”. Office Action, pg. 6, lines 6-7 (citing the definition of “pipeline” from www.credoreference.com).

The Applicants respectfully disagree. Initially the Applicants note that the definition of “pipeline” from www.credoreference.com does not appear to be publicly accessible.

The standard for determining the public accessibility of a reference was recently reviewed by the Federal Circuit. See *SRI Int'l, Inc. v. Internet Sec. Sys.*, 511 F.3d 1186, 1194-95 (Fed. Cir. 2008). “Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986) (emphasis added). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006); see also *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743 (S.D.N.Y. 1966)). “The decision whether a particular reference is a printed publication ‘must be approached on a case-by-case basis.’” *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989) (internal quote from *In re Hall*, 781 F.2d at 899).

Here, the www.credoreference.com website is not publicly accessible because the content of the website is restricted to registered users and is password protected. Consequently, the definition of “pipeline” cited by the Examiner from the www.credoreference.com website fails to meet the standard of “publicly accessible”

such that “persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *See Bruckelmyer*, 445 F.3d at 1378. As such, the Examiner may not rely upon this reference to support the instant § 102(b) rejection.

Moreover, the Applicants note that, despite the Examiner’s attempted assertion that the www.credoreference.com reference was cited to show the inherent properties of the Cattell device, the www.credoreference.com reference is actually only being used to explain the meaning of a term used in the primary Cattell reference. As such, MPEP § 2131.01(II) applies.

The Applicants further note that MPEP § 2131.01(II) explicitly states that extrinsic evidence can be taken into consideration if it shows the meaning of a term used in a cited reference.¹ MPEP § 2131.01(II) reads in relevant part as follows:

Extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter. *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Baxter Travenol Labs. invention was directed to a blood bag system incorporating a bag containing DEHP, an additive to the plastic which improved the bag’s red blood cell storage capability. The examiner rejected the claims over a technical progress report by Becker which taught the same blood bag system but did not expressly disclose the presence of DEHP. The report, however, did disclose using commercial blood bags. It also disclosed the blood bag system as “very similar to [Baxter] Travenol’s commercial two bag blood container.” Extrinsic evidence (depositions, declarations and Baxter Travenol’s own admissions) showed that commercial blood bags, **at the time Becker’s report was written**, contained DEHP. Therefore, one of ordinary skill in the art would have known that “commercial blood bags” meant bags containing DEHP. The claims were thus held to be anticipated.).

MPEP § 2131.01(II) (emphasis added).

Therefore, consistent with the relevant case law discussed in MPEP § 2131.01(II), it is axiomatic that extrinsic evidence must show the meaning of a term *at the time the cited reference was written*.

In this case, Applicants submit that the Examiner has erred in that he has not provided any evidence that the www.credoreference.com definition accessed online on March 2, 2008, bears any relation to the meaning of “pipelined” in the Cattell abstract, which is dated over seven years earlier (September 12, 2000). Moreover,

¹ MPEP § 2131.01(II) is explicitly clear: Extra References or Other Evidence Can Be Used to Show Meaning of a Term Used in the Primary Reference.

the Examiner has provided no support, and it is not clear to the Applicants whether the definition cited by the Examiner was available at the www.credoreference.com website in September 2000. In other words, the www.credoreference.com definition of March 2, 2008 (which is extrinsic evidence in that it is believed to explain the meaning of a term in Cattell's abstract) cannot provide the meaning of a term at the time the Cattell abstract was written because it is not clear if that definition existed in September 2000.

Therefore, the sole piece of evidence cited by the Examiner to support an allegedly alternative interpretation of the term "pipelined" in the Cattell abstract may not be relied upon to support the instant rejections. These rejections should be withdrawn for this reason alone.

Notwithstanding the above, even if the Examiner was using the www.credoreference.com reference to show the alleged inherent properties of the Cattell device, the www.credoreference.com reference is insufficient to establish such inherency.

In addressing rejections based upon the alleged inherent characteristics contained in a prior art reference, the Federal Circuit has held that, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original); *see also* MPEP § 2112(IV). In addition, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original); *see also* MPEP § 2112(IV).

Here, the Applicants and the Examiner both agree that the Cattell abstract does not explicitly mention a scanner system that extracts data obtained from a first array while a second chemical array is being read.² As best understood by the Applicants, the Examiner's position hinges on the interpretation of the word "pipelined" in the Cattell abstract (i.e., as it appears in the phrase ". . . the system, which is left to scan and feature extract unattended in a pipelined fashion.").

² See Office Action dated March 11, 2008, pg. 8, lines 4-6 ("While Cattell et al. do not explicitly recite

The Applicants initially note that term “pipeline”, as used as a verb, e.g., in the phrase “to pipeline information” appears to be jargon. Furthermore, the Applicants submit that at the time the Cattell abstract was written (i.e., September 2000), the accepted definition of “pipeline” is as follows:

1. A conduit of pipe, especially one used for the conveyance of water, gas, or petroleum products.
2. A direct channel by which information is privately transmitted.

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Given the analogy to water or oil flowing down a pipeline, the plain meaning of the term in the context of Cattell’s abstract is clear: the term “pipelined” refers to a process through which data is processed as if the data is traveling down a pipeline. Moreover, a “pipeline” is defined as a “direct channel”. Thus, by analogy to a pipeline or a “direct channel”, Cattell’s system is therefore one that processes data using “one after the other” methods. Such methods are *sequential*. As such, the Applicants believe that a fair reading of the Cattell abstract indicates that scanning and feature extraction occur one after the other (i.e., *sequentially*) rather than simultaneously, as would be required by the rejected claims.

Consequently, the Examiner’s alleged alternative interpretation of the term “pipelined” in the Cattell abstract does not necessarily flow from the alleged teachings of the applied prior art, especially in light of the Examiner’s failure to provide a definition of “pipeline” at the time the Cattell abstract was written. Therefore, the www.credoreference.com reference is insufficient to establish any inherent properties of the Cattell device. As such, these rejections may be withdrawn.

In light of the above discussion, the Applicants contend that Cattell, as evidenced by www.credoreference.com does not anticipate the rejected claims. Thus, the Applicants respectfully request that the 35 U.S.C. § 102(b) rejection of Claims 1, 3-4 and 11 be withdrawn.

the simultaneity of the reading and extracting data . . .”).

Claim Rejections – 35 U.S.C. § 103

Claims 2, 5-9, 10, 22-23, 24-27, 28, and 36-38 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cattell et al., *supra*, as evidenced by the definition of “pipeline” (obtained online at www.credoreference.com on March 2, 2008), and further in view of a variety of secondary references (e.g. Li et al. (U.S. Patent No. 6,571,005), Besemer et al. (U.S. Patent No. 6,399,365), Rava et al. (U.S. Patent No. 5,874,219), Ambrose et al (U.S. Patent No. 6,309,886), Milosavijevic et al. (U.S. Application Publication No. 2004/0098204), and Kallioniemi et al. (U.S. Application Publication No. 2003/0215936).

As discussed in detail above, the Cattell abstract is deficient in that it relies on what appears to be an erroneous interpretation of the word “pipelined” at the time the Cattell abstract was written. None of the secondary references cited by the Examiner remedy the deficiencies of Cattell. Therefore, a *prima facie* case of obviousness cannot be maintained, and the Applicants respectfully request withdrawal of these rejections.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone James Keddie at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10010010-1.

Respectfully submitted,
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